

Application No.: 09/833942

Case No.: 56319US002

Remarks

Claims 23-26, 28-33, 35-37, and 48 are pending. Reconsideration of the application in view of the following remarks is respectfully requested.

Claims 23-26, 28, 29, 31-33, 35, 36, and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Yamato (U.S. Pat. No. 6,528,154) in view of Lise et al. (U.S. Pat. No. 6,406,504). Applicants respectfully traverse this rejection because it relies on non-analogous art, and there is no evidence of record indicating that those of ordinary skill would have been properly motivated to combine them, much less to combine them in a manner that would have produced Applicants' claimed invention.

The Office Action fails to acknowledge that the teaching of Yamato is in a different field of endeavor and is not pertinent to the claimed invention. In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992); *M.P.E.P.* 2141.01(a). The Yamato '154 patent is directed to makeup sponge puffs. The makeup sponge puffs reported by Yamato are used to apply makeup beauty products, such as foundation in particular, to skin (see, e.g., column 1, lines 6-8). In contrast, Applicant's claimed invention relates to cleaning articles. The cleaning articles disclosed by Applicants can be used, for example, to clean soiled painted aircraft surfaces without significantly changing the gloss (see, e.g., page 6, lines 13-18). The Yamato '154 patent is not related to cleaning articles and is not concerned with the gloss of painted surfaces. Accordingly, the Yamato '154 patent is non-analogous art and therefore, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Further, the Office Action fails to identify any reason why the skilled artisan would have been motivated to combine the respective teachings of Yamato and Lise in a way that would have produced a claimed invention. Patent claims cannot be found obvious in view of a combination of references unless there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). "A critical step in analyzing the

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patentability of claims pursuant to section 103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). "In other words, the examiner must show reasons that the skilled , artisan, confronted with the same problems as the inventor, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The reasons for the combination must be articulated with specificity. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Although the Office Action asserts that it would have been obvious to one of ordinary skill in the art to modify the teachings of the Yamato '154 patent to include a binder composition disclosed in the Lise '504 patent, the Office Action does not take account of the fact that the references are directed to different fields of endeavor. The Yamato '154 patent, for example, is directed to makeup sponge puffs, whereas the Lise '504 patent is directed to abrasive articles.

The Office Action fails to acknowledge that there are substantial differences in the design and performance parameters one would consider for makeup sponge puffs as compared to abrasive articles. Indeed, the properties of materials one would choose for a makeup sponge puff are different from the desired properties of an abrasive article. The makeup sponge puffs reported by Yamato are used to **apply** makeup beauty products, such as foundation in particular, to skin (see, e.g., column 1, lines 6-8). The makeup sponge puff reported by Yamato decreases the contact area between the skin and the makeup sponge puff to **reduce** frictional resistance (see, e.g., column 4, lines 1-3). In contrast, the abrasive articles reported by Lise are used to **clean, polish, and abrade** wood, metal, plastic, and the like (column 1, lines 32-35). Frictional resistance is necessary to the cleaning, polishing, and abrading operations reported by Lise. The design of an item for cleaning, polishing, and abrading wood, metal, and plastic would not be considered by one skilled in the art seeking to improve the design of an item for applying makeup to skin. Therefore, a person of ordinary skill, aware of the fundamental differences between abrasive articles and makeup sponge puffs, would not be motivated to modify the makeup sponge puff reported in the Yamato '154 patent with an abrasive binder composition reported in the Lise '504 patent.

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Further, assuming, *arguendo*, that one were motivated to combine the teachings of the Yamato '154 and Lise '504 patents, one skilled in the art would not have a reasonable expectation of success when modifying the makeup sponge puff reported by Yamato to include a binder from the abrasive article reported by Lise. To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success when combining references. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). As discussed above, the makeup sponge puff reported by Yamato is designed to reduce frictional resistance. Yamato does not reveal any deficiencies with the binder compositions reported therein, nor does Yamato consider the effect that using a binder comprising at least one of nitrile rubber, styrene-butadiene rubber, or polyisoprene would have on the frictional properties of a makeup sponge puff. Accordingly, one skilled in the art would not have a reasonable expectation of success when modifying the makeup sponge puff reported by Yamato to include a binder from the abrasive article reported by Lise.

Since there is no reason to believe that those of ordinary skill seeking to develop makeup sponges would have been motivated to consult the abrasive arts, much less to combine them in a manner that would have successfully produced Applicants' claimed invention, a *prima facie* case of obviousness has not been made. For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 23-26, 28, 29, 31-33, 35, 36, and 38 under 35 U.S.C. § 103.

Claims 30 and 37 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the Lise '504 patent in view of the Yamato '154 patent. Applicants respectfully traverse this rejection because, as discussed above, the cited references are from different fields, and there is no evidence of record indicating that those of ordinary skill would have been motivated to combine them, much less to combine them in a manner that would have produced Applicants' claimed invention. For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 30 and 37 under 35 U.S.C. § 103.

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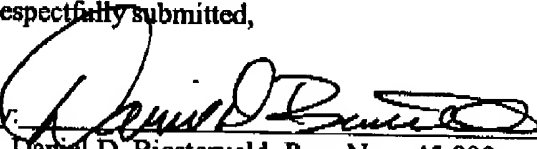
Conclusion

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. The Examiner is invited to contact Applicants' undersigned representative with any questions concerning the present application.

Respectfully submitted,

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Date

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